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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,327	10/31/2003	Edward Alan Clark	LUC-427/Clark 9	9809
32205 7590 01/18/2008 PATTI, HEWITT & AREZINA LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER NGUYEN, QUYNH H	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 01/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/698,327

Applicant(s)

CLARK, EDWARD ALAN

Examiner

Quynh H. Nguyen

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/31/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 17 are Single Means Claims. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08(a).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "an article comprising computer-readable signal-bearing media" which contradicts each other as 'an article' is an apparatus which does not comprise of 'signal-bearing media'. Appropriate clarification and/or correction are required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 20, claims the non-statutory subject matter of a signal-bearing media. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional

change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed signal-bearing media are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show alphabetic components as described in the specification. For example, Fig. 1, element 105 should also label telephony device. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Benedyk et al. 2005/0033684).

As to claim 1, Benedyk et al. teaches an apparatus (Fig. 1) comprising: An intermediate application server component (Fig. 1, 108) that provides one or more services (page 1, [0005]) to one or more telephony devices (Fig. 1, 106) on a call through employment of one or more data streams associated with the call (Fig. 1, 104; page 2, [0016] - [0019]).

As to claim 2, Benedyk et al. teaches the apparatus of claim 1, wherein the intermediate application server and one or more user-related application server components establish the one or more data streams (page 2, [0017]); wherein the intermediate application server component provides the one or more services to the one or more user-related application server components through employment of the one or more data streams (page 2, [0017] - [0018]).

As to claim 3, Benedyk et al. teaches the apparatus of claim 2, wherein the one or more user-related application server components cooperate with the one or more telephony devices to establish one or more web portals (page 2, [0017] - [0018] - *Internet is a web portal*) that are employable by the intermediate application server (Fig. 1, 108) and the one or more user-related application server components to provide the one or more services to the one or more telephony devices (page 2, [0017] - [0018], [0037] - [0039]).

As to claims 4, 14 and 18, Benedyk et al. teaches the apparatus of claim 3, wherein the intermediate application server component and the one or more user-related application server components provide one or more interfaces associated with the one or more services to the one or more telephony devices through employment of the one or more web portals for employment by the one or more telephony devices in interaction with the one or more services (page 2, [0017] - [0018]).

As to claim 5, Benedyk et al. teaches the apparatus of claim 4, wherein the intermediate application server component cooperates with the one or more telephony devices to establish the call; wherein the intermediate application server component alters the call based on the interaction with the one or more services (page 2, [0018] - [0019]).

As to claims 6 and 19, Benedyk et al. teaches the apparatus of claim 4, wherein the intermediate application server component alters one or more of the one or more interfaces based on the employment of the one or more services (page 2, [0018] - [0019]); wherein the intermediate application server component and the one or more

user-related application server components cooperate to update the one or more of the one or more interfaces through employment of the one or more data streams (page 2, [0019] - [0020]).

Claims 7 and 8 are rejected for the same reasons as discussed above with respect to claims 4 and 6. Furthermore, Benedyk et al. teaches a first telephony device (Fig. 1, 106) and a second telephony device (Fig. 2, 102).

As to claim 9, Benedyk et al. teaches the apparatus of claim 4, wherein the intermediate application server component and the one or more user-related application server components provide the one or more graphical user interfaces that are employable by the one or more telephony devices (page 4, [0033] - *the purchase price and the store/sales displayed to the subscriber on a display screen associated with PoS device 125*).

As to claim 10, Benedyk et al. teaches the apparatus of claim 9, wherein the intermediate application server component employ the extended Markup Language interfaces (page 5, [0039]) to provide the one or more graphical user interfaces.

As to claim 11, Benedyk et al. teaches the apparatus of claim 3, wherein the intermediate application server component and the one or more user-related application server component employ the HTTP to provide the one or more web portals to the one or more telephony devices (page 5, [0039]).

As to claim 12, Benedyk et al. teaches the apparatus of claim 1 further comprising: an intermediate switch component (102, 104); wherein the intermediate switch component and the one or more telephony devices cooperate to establish the

call (page 4, [0035]); wherein the intermediate switch component communicates with the intermediate application server component to establish the one or more data streams associated with the call (page 5, [0039]).

As to claim 13, Benedyk et al. teaches the apparatus of claim 12, wherein the intermediate application server component associates the one or more services with the call and communicates with the intermediate switch component to update the one or more voice portions of the call based on the one or more services ([0036] - [0037]).

As to claim 17, Benedyk et al. teaches a method comprising: providing, by one or more portions of an intermediate network, one or more services (page 1, [0005]) to one or more telephony devices (Fig. 1, 106) on a call through employment of one or more data streams associated with the call (Fig. 1, 104; page 2, [0016] - [0019]; page 4, [0035]).

As to claim 20, Benedyk et al. teaches an article comprising: one or more computer-readable signal-bearing media; means in the one or more media for providing, by one or more portions of an intermediate network, one or more services (page 1, [0005]) to one or more telephony devices (Fig. 1, 106) on a call through employment of one or more data streams associated with the call (Fig. 1, 104; page 2, [0016] - [0019]; pages 4 and 5, [0035] - [0037]).

***Allowable Subject Matter***

9. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 15 and 16, prior of records fail to teach, or render obvious, alone or in combination, an apparatus / method comprising the claimed means and their components, relationships, and functionalities as specifically recited in claims 15 and 16 and claims that they depend on.

### **Double Patenting**

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/698141. Claims 1-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/698328. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader in scope than the claims of the copending Applications. Omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. In re KARLSON (CCPA) 136 USPA 184 (1963).

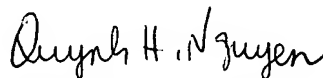
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Savage, III et al. (2001//0009014) teaches facilitating real-time, multi-point communications over the Internet.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Quynh H. Nguyen**  
**Primary Examiner**  
**Art Unit 2614**